



REMARKS

Applicants respectfully note that the Examiner stated on the Official Action summary that claims 1-10 are pending in this application. However, the Examiner apparently failed to realize that a Preliminary Amendment was filed concurrently with this application, which canceled claim 10 and added new claim 11.

Upon entry of the amendment filed herewith, claims 1-9 and 11-12 will be pending in the present application. Applicants respectfully submit that the amendment does not introduce new matter within the meaning of 35 U.S.C. § 132. Accordingly, entry of the amendment is respectfully requested.

1. Objection to claims 3 and 8

The Official Action states that claims 3 and 8 are objected to as being dependent on a rejected base claim, but would allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

RESPONSE

Applicants thank the Examiner for this indication of allowable subject matter. However, in view of applicants arguments outlined herewith, the rejection of base claim 1 is improper and applicants have not amended claims 3 or 8 to remove this objection. Since the rejection of claim 1 is improper, the objection to claims 3 and 8



is also improper.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the objection to claims 3 and 8.

2. Rejection of claim 9 under 35 U.S.C. §112, 2nd paragraph

The Official Action states that claim 9 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As the basis of this rejection, the Official Action states, in relevant part:

Claim 9 is rejected because the term "medicament" is confusing. What is "medicament" means? Does it mean "pharmaceutical composition"? Correction is required.

Claim 9 is rejected because the claims are self-conflicting. Pharmaceutical composition by definition must be effective yet non-toxic. Claim 9 is pharmaceutical composition without dosage limitation, i.e. included both ineffective and toxic amount. It is recommended that "therapeutically effective amount" be incorporated into the claims.

RESPONSE

Regarding the rejection of claim 9 due to the term "medicament", applicants respectfully point out to the Examiner that the term "medicament" is not present in the pending claims. Applicants deleted this term and replaced it with the phrase "pharmaceutical composition" in the Preliminary Amendment filed

concurrently with this application on May 12, 2005. Thus, rejection of claim 9 on this ground is improper on its face.

Regarding the rejection of claim 9 due to the lack of a recitation of a "therapeutically effective amount", applicants respectfully point out to the Examiner that claim 9 has been currently amended to recite the suggested language.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 9.

3. Rejection of Claim 10 under 35 U.S.C. §101 and §112, 2nd

paragraph

The Official Action states that claim 10 is rejected under 35 U.S.C. §101 and §112, 2nd paragraph.

RESPONSE

In this regard, applicants respectfully point out to the Examiner that claim 10 was cancelled without prejudice in the Preliminary Amendment filed concurrently with this application on May 12, 2005. Thus, rejection of claim 10 is moot.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

4. Rejection of Claims 1-2 and 4-7 under 35 U.S.C. § 102(b)

The Official Action states that claims 1-2 and 4-7 stand

rejected under 35 U.S.C. §102(b) for the following reasons:

Claims 1-2 and 4-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ranier et al. WO 9005136. Ranier et al. disclosed the instant claimed compounds on page 18.

Compound 6: 8-(trans-2-cyclopropylcarbonyloxy-2,3-dihydro-1-indenyloxy)-3-hydroxymethyl-2-methyl-imidazo[1,2-a]pyridin

Compound 32: 8-(trans-2-cyclopropylcarbonyloxy-2,3-dihydro-1-indenyloxy)-2-methyl-imidazo[1,2-a]pyridin

RESPONSE

Applicants respectfully traverse this rejection.

First of all, as a clerical point, applicants respectfully point out to the Examiner that the Rainer et al. reference discloses as compound 32 on page 23, the compound "8-(trans-2-cyclopropylcarbonyloxy-2,3-dihydro-1-indenyloxy)-3-formyl-2-methyl-imidazo[1,2-a]pyridin". In contrast, the Examiner alleged that compound 32 was listed as "8-(trans-2-cyclopropylcarbonyloxy-2,3-dihydro-1-indenyloxy)-2-methyl-imidazo[1,2-a]pyridine". In any event, the compounds that the Rainer et al. reference discloses do not anticipate the presently rejected claims.

The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. The

identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Rainer et al. reference does not teach "each and every element" of the presently pending claims since compounds 6 and 32 of the Rainer et al. reference each require a "cyclopropylcarbonyloxy" substituent at the 2-position. In contrast, the corresponding position of the presently claimed compounds (i.e., the R4 definition of substituent Z) cannot be a cyclopropylcarbonyloxy substituent.

As such, the Rainer et al. reference fails to anticipate the presently pending claims, rendering this rejection improper on its face.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-2 and 4-7.

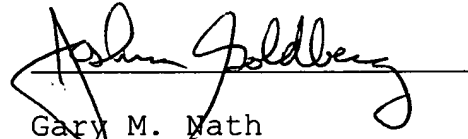
CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the objection and rejections of record. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if he has any questions or comments.

Respectfully submitted,

NATH & ASSOCIATES PLLC

A handwritten signature in dark ink, appearing to read "Gary M. Nath", is written over a horizontal line.

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